



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,206	12/18/1998	HEIDI KAY	EWG-079	1079

7590

10/20/2005

IAN R. BLUM
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS
41ST FLOOR
NEW YORK,, NY 10036-2714

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/216,206	Applicant(s) KAY ET AL.	
	Examiner James W. Myhre	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004 and 27 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-39, 41-50 and 54-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-39, 41-50, and 54-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/4/04, 5/19/05, 8/</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments filed on September 22, 2004 ('04) and July 27, 2005 ('05) have been considered and are sufficient to overcome the Hanson et al (5,974,398) and Gerace (5,991,735) references. The '04 amendment canceled Claims 1-13, 19-23, 28, 40, and 51-53 and amended Claims 29, 31, 39, 41, 45, 48, 49, 54, 56, 58, 60, and 61, which resulted in the pending claims being Claims 29-39, 41-50, and 54-61. The '05 amendment did not cancel any further claims, but did amend Claims 29, 31-35, 39, 41, 47, and 60. Therefore, the currently pending claims considered below are Claims 29-39, 41-50, and 54-61.

Claim Rejections - 35 USC § 101

2. The '04 and '05 amendments have overcome the rejections of Claims 29, 31-37, 39, 41, 43-49, 51-54, and 56-60 under 35 U.S.C. 101 in paragraph 4 of the March 14, 2004 office action. Thus, the Examiner hereby withdraws those rejections.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 3622

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 29-39, 41-50, and 54-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,285,987. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are directed to a system and method "for supplying advertisements ... during the display of web pages" by receiving bids from advertisers that include the monetary amount of the bid and the desired specifications of the advertiser as to what criteria a web page needs to meet and by selecting and transmitting one or more advertisements to be displayed to a viewer of the web page that meet this criteria. The claims in the current application are directed to a system and method "for determining an advertisement to provide for fulfilling an advertising opportunity" ... "to place the advertisement on a web page" by receiving bids from advertisers that include a bid amount and at least one characteristic that a web page must meet and determining which advertisement(s) meet the advertiser's selection criteria. While some of the current claims do not explicitly include the last step of transmitting the selected advertisement(s) to the viewer, Claim 16 does include the step. Furthermore, it is claimed that charges for the display of the advertisement will be calculated and charged to the advertiser, which implies that the advertisement(s) have been transmitted to the viewer. Thus, both sets of claims are

Art Unit: 3622

directed to a system and method for advertisers to bid on the opportunity to present advertisements to online user as they browse web pages.

Allowable Subject Matter

5. Claims 29-39, 41-50, and 54-61 are allowed.

Statement of Reasons for the Indication of Allowable Subject Matter

6. The following is a statement of reasons for the indication of allowable subject matter:

While prior art was found which disclosed selecting customized advertisements on the Internet (Dedrick, 5,724,521; and Robinson, WO 9,726,729) and prior art was found that disclosed receiving bids from advertisers to fill advertising spot on websites (Hanson et al (5,974,398) and Frook, "Interactive Age", page 1), prior art was not found that disclosed nor render it obvious to combine the cited references to arrive at the claimed invention, which also includes performing the steps in real time ("subsequent to a request for the web page by a browser") as in independent claims 29, 41, 49, and 54. Thus, the non-obvious novelty of the invention is the real time bidding process to insert targeted advertisements conducted during the downloading of the requested web page.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

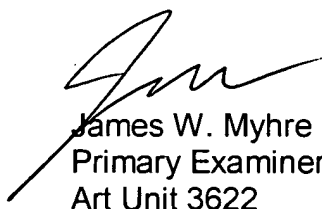
Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM

October 4, 2005



James W. Myhre

Primary Examiner

Art Unit 3622